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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,451	12/31/2003	Ross Koningstein	Google-41 (GP-099-00-US)	4989

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EXAMINER	
BEKERMAN, MICHAEL	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 10/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,451	KONINGSTEIN ET AL.	
	Examiner	Art Unit	
	Michael Bekerman	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-56,59-84 and 86-88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-56,59-84 and 86-88* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/6/06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to papers filed on 6/21/2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 2-4, 12, 13, 15-17, 25, 26, 28-30, 38, 39, 43-45, 53, 54, 66, 67, 69-71, 79, and 80 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements.** See MPEP § 2172.01.

Regarding claims 2-4, 15-17, 28-30, 43-45, 56, and 69-71, the omitted elements relate to the following: No advertisements are previously claimed, only keywords with a primary function of targeting advertisements. In the above claims, limitations are being recited on advertisements that have never actively been targeted or served. There appears to be a missing step of targeting or serving advertisements.

Regarding claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80, the omitted elements relate to the following: It is unclear as to how unused inventory and unused ad spots are determined. No inventory of advertisements is previously claimed, nor is there any mention that part of that unsaid inventory may be unused. Examiner recommends the defining a webpage with a finite number of ad spots, the showing of

advertisements on the webpage, and the determining that not all ad spots are filled to define unused inventory.

2. **Claims 12, 25, 38, 53, 66, and 79 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 12, 25, 38, 53, 66, and 79, these claims recite the limitation "available ad spots". There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 3-10, 14, 16-23, 27, 29-36, 40-42, 44-51, 55, 59-64, 68, 70-77, 81-84, and 86-88 are rejected under 35 U.S.C. 102(e) as being anticipated by Paine (U.S. Pub. No. 2003/0055816).** Paine shows a method and apparatus for recommending search terms to an advertiser that includes all of the limitations recited in the above claims.

Referring to claims 1, 14, 42, 55, 86, and 87, Paine teaches a method and apparatus for determining one or more ad targeting keywords comprising accepting at least one category (search terms in the initial list are considered to be categories), determining one or more keywords using the accepted at least one category, providing the determined one or more keywords as suggested targeting keywords to an advertiser, accepting advertiser input in response to the suggested targeting keywords, and determining whether or not to provide at least some of the determined one or more keywords as targeting keywords for an ad using the accepted advertiser input (Paragraph 0107, Sentence 1). If keywords are gathered using existing information (as taught by Paine), this is a step of looking up those keywords. Since categories are used to look up keywords, this look-up is taken to be a specific association.

Referring to claims 3, 4, 16, 17, 29, 30, 44, 45, 70, and 71, Paine teaches the determining of at least one category using ad creative information and information from a landing webpage of the advertiser (Abstract, Sentence 2). Examiner considers an advertiser website to contain ad creative information. Paine teaches advertisements as having ad creative information for rendering the ad (different descriptions) and a landing webpage linked from the advertisement (Figure 7).

Referring to claims 5, 18, 31, 46, 59, and 72, Paine teaches inverted an keyword index in which categories are provided as lookup keys to keywords (Paragraph 0080, Sentences 1-4). Examiner considers each of Paine's subaccounts (which refer to different keywords) to be a different category.

Referring to claims 6, 19, 32, 47, 60, and 73, Paine teaches the performing of qualification testing of the determined one or more keywords to determine if a keyword is qualified or unqualified for use as an ad targeting keyword and the providing of those qualified keywords as ad targeting keyword (Abstract, Sentence 3).

Referring to claims 7-10, 20-23, 33-36, 48-51, 61-64, and 74-77, Paine teaches the tracking of the performance of the ads served using an ad targeting keyword. Paine's tracking is performed in general as well as across specific categories, including the accepted category (Paragraph 0087, Sentences 5-7).

Referring to claims 27, 40, 41, 68, 81-84, and 88, Paine teaches a method and apparatus for generating one or more keywords as candidates for use as ad targeting keywords, comprising the accepting of ad information, the determining of one or more categories using the accepted ad information (Abstract, Sentences 1-3), the recommending of at least one of the one or more of the categories to an advertiser, and the accepting of feedback with respect to the recommended one or more categories (Paragraph 0107, Sentence 1). The search terms referred to by Paine are viewed as serving constraints for the advertisements. By comparing an advertiser to other similar advertisers (Abstract, Sentence 3), the system would have to determine the initial advertiser's product category. If keywords are gathered using existing information (as taught by Paine), this is a step of looking up those keywords. Since categories are used to look up keywords, this look-up is taken to be a specific association.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 11-13, 15, 24-26, 28, 37-39, 43, 52-54, 56, 65-67, 69, and 78-80 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paine (U.S. Pub. No. 2003/0055816).

Referring to claims 2, 15, 28, 43, 56, and 69, Paine's invention doesn't teach a tool that keeps track of negative ad targeting keywords. Paine does teach that it is well known to have a tool to keep track of two lists, a list of good words for an advertiser's site and a list of negative keywords having no relation to the advertisers site or content (Paragraph 0008, Sentence 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include negative keywords into the system of Paine. This would allow more accuracy in relation to relevant keywords.

Referring to claims 11, 24, 37, 52, 65, and 78, Paine teaches a system for recommending ad targeting keywords for ads displayed on a search site. Paine doesn't go into detail about the type of space that will be used for the ad on the search site. Official notice is taken that it is well known when a new advertisement is added to a search page, it will be added to an ad spot that would otherwise be unused. It would have been obvious to one having ordinary skill in the art at the time the invention was made to specify an advertisement as being served on a portion of the webpage that

would otherwise be unused. This would keep the operator of the search site from overlapping other information with an advertisement.

Referring to claims 12, 13, 25, 26, 38, 39, 53, 54, 66, 67, 79, and 80, Paine teaches filling unused inventory ad spots with unpaid listings generated by a search engine (Paragraph 0075, Sentences 10-11). Paine does not teach any attempt to fill those unused spots with other paying advertisements. It would have been obvious to one having ordinary skill in the art at the time the invention was made that the webpage owner would want to recommend keywords to a paying advertiser for which there were more spots available. This will ensure that less ad spots will be unpaid-for.

Response to Arguments

5. **In response to the 102(e) rejection of claims 1, 3-10, 14, 16-23, 27, 29-36, 40-42, 44-51, 55, 57-64, 68, 70-77, and 81-85**, applicant argues that neither spidering, nor collaborative filtering, nor their combination, teach an act of or means for determining one or more keywords using at least one category. Applicant state's on page 26 of the current arguments that "spidering may provide recommended search terms which a new advertiser may accept or reject" and "collaborative filtering may be used to provide an updated list of search terms which may be accepted or rejected" (both of these concepts are taught by Paine). Examiner considers a search term to be a category. In figure 9, Paine uses "automobile" as an example of a search term. On page 28 of the current arguments, applicant refers to "automobile" as an example of a category. Applicant currently argues "the fact that a particular term might be used as a label

representing a category does not mean that the same term, when used as a search term, represents a category". Examiner contends that a category is simply a term in which to describe other data which may fall under the umbrella of the original term. Based on this information, Paine reads on the above claims and the rejection still stands.

6. **In response to the 103(a) rejection of claims 2, 15, 28, 43, 56, and 69**, applicant argues that Paine teaches "positive and negative scores assigned to keywords for determining whether a new advertiser is similar to an existing advertiser." Paragraph 0008 of Paine recites: "This tool keeps track of two lists; an accept list of good words for an advertiser's site, and a reject list of bad words or words that have no relation to the advertiser's site or it's content". Examiner feels that this is sufficient material to read over the above claims and the rejection still stands. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). This argument is further relevant for any other arguments of improper hindsight for any of the other claims rejected under 103(a).

7. **In response to the 102(e) rejection of claims 5, 18, 31, 46, 59, and 72**, applicant argues "the Examiner is interpreting "category" inconsistently to mean both

"terms" and advertiser "subaccounts". Examiner invited applicant to reread paragraph 0080 of Paine, in which Paine refers to each subaccount as identifying different keywords, which the Examiner considers to be categories. For further clarification, see Figure 9 of Paine. Thus, the rejection still stands.

8. **In response to the 103(a) rejection of claims 11, 24, 37, 52, 65, and 78,** applicant argues that "the Examiner's conclusion that when a new advertisement is added to a search page, it will be added to an ad spot that would otherwise be unused is false". Examiner contends that a web page developer would not put 2 advertisements on top of one another in the interest of both items being viewable. Thus, the rejection still stands.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB

JEFFREY D. CARLSON
PRIMARY EXAMINER